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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,446	12/26/2001	Rick K. Southern	D9426	1727

7590

12/20/2002

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EXAMINER

DORSEY, DENNIS

ART UNIT

PAPER NUMBER

3637

DATE MAILED: 12/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/034,446

Applicant(s)

SOUTHERN ET AL.

Examiner

Dennis L Dorsey

Art Unit

3637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Objections

1. Claim 1 is objected to because of the following informalities: the phrase "Method" in line 1 should read "A method". Appropriate correction is required.
2. Claim 2 is objected to because of the following informalities: the phrase "A method" in line 1 should read "The method". Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. Regarding claims 3 and 10, the step of preparing said concrete floor surface is indefinite as claimed since it appears impossible to prepare the concrete surface after the floorboards have been adhesively applied to the concrete surface and allowed to set.
4. Regarding claims 4 and 11, the limitation of "using boards made of hardwood or soft wood" is indefinite since claim 1, in which claims 4 and 11 directly or indirectly depend from, has set forth the limitation of the boards being hardwood.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-2 and 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Cohn Patent Number 2,860,385.

Cohn '385 teaches all the limitations of the above claims including hardwood floorboards (12, column 1, lines 54-55), adhesively attached (10) to concrete floor surface (12) with no subflooring (column 1, lines 15-21), and making the finishing strips by proper woodworking machinery (column 1, lines 54-55) inherently provides top surface (16) with colors (natural colors of the wood) and a finish (rough finish or smoothed machined finish).

Cohn '385 further teaches the steps of preparing the floorboard away from the site of installation (column 1, lines 54-55), prepare the concrete surface (column 1, lines 59-61), applying adhesive (column 2, lines 32-33), placing floorboard (column 2, lines 34-35), and allowing the floorboard to set (column 2, lines 35-44).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohn Patent Number 2,860,385.

Cohn '385 teaches all the limitations of the above claims except specifically to clean, dry, smooth, flatten, and low moisture the surface of the concrete floor. It is held to well known in the art to prepare a floor surface to be clean and free of water to insure proper adhesion of an adhesive to added to the floor surface. It would have been obvious for one skilled in the art at the time the invention was made to prepare the

Art Unit: 3637

surface of the concrete floor in the Cohn'385 reference since it is held to within the skill of a worker in the art to clean, dry, smooth, and make substantially flat a floor surface when adding an adhesive for securing flooring products to ensure a strong and proper adhesion of the flooring products.

9. Claims 4, 7-9, and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohn Patent Number 2,860,385 in view of Sweet Patent Number 5,894,700.

Cohn '385 teaches all the limitations of the above claims except specific dimensions of the floorboards or the nailing of the floorboards to the concrete floor. Sweet '700 teaches that it is well known in the art to nail wood flooring strips to a subfloor (column 1, lines 6-13). It would have been obvious for one skilled in the art to further nail the floorboards as taught by Sweet'700 since it is held to within the skill of a worker in the art to strength the flooring connection. Sweet '700 further teaches that the flooring strips can be any suitable length and varying thickness (column 3, lines 65-67). It would have been obvious for one skilled in the art at the time the invention was made to provide floorboards with a length of at least three feet and varying thickness since it is held to within the skill of a worker in the art to provide such floorboards as a matter of obvious design choice.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sweet et al. Patent Number 5,830,549; Omholt Patent Number 4,233,793; and Marino Patent Number 3,365,850.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis L Dorsey whose telephone number is 703-306-9137. The examiner can normally be reached on Monday-Friday 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1020.

DLD 
December 16, 2002

LANNA MAI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

